

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 07 July 2008, have been fully considered and are persuasive. The previous rejections of the claims have been withdrawn.

EXAMINER'S AMENDMENT

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

3. Authorization for this examiner's amendment was given in a telephone interview with Peter Weissman, no. 40,220 on 17 October 2008. The examiner suggested the changes to the claims to place the application in condition for allowance because:

a. "with at least one marking visible under normal lighting conditions", previously added to line 2 of claim 15, appeared to be new matter. It appears the claimed marking corresponds to the markings 56 shown in Fig. 3, which as described in the specification on p. 4, ll. 25-28, are placed on the semi-transparent layer 20. Therefore, claiming that the substrate had a marking appeared to be new matter. The examiner suggested that the claim should recite that the marking was on the semi-transparent layer. See MPEP §608.04.

b. Claim 18 was an improper dependent claim. Claim 18 depended from independent claim 15, which used the closed transitional phrase "consisting of."

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However, claim 18 recited additional features, and a claim depending from a claim which uses the transitional phrase “consisting of” may not add any steps or elements to the claimed invention. See MPEP § 2111.03

4. The following amendments are made as directed by the Applicant in an email communication sent to the examiner by the Applicant, and included in this Examiner’s Amendment as an attachment. The application has been amended as follows:

In the Claims:

Claim 15, line 2, --with at least one marking visible under normal lighting conditions-- has been deleted.

Claim 15, line 4, “, the semi-transparent layer having at least one marking visible under normal lighting conditions” has been inserted before the period at the end of the line.

Claim 18 has been cancelled.

Claim 19 has been cancelled.

Claims 22-26 have been added as follows:

Claim 22. (New) A dial consisting of:

a substrate plate;

a continuous semi-transparent layer covering at least part of said substrate plate of a material allowing light to pass, the semi-transparent layer having at least one marking visible under normal lighting conditions;

phosphorescent, fluorescent or luminescent luminous elements lodged between said substrate plate and said semi-transparent layer, and wherein said luminous

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elements are lodged in blind hollows made in said semi-transparent layer and open towards said substrate plate; and,

a colored layer interposed between said substrate plate and said semi-transparent layer;

wherein said luminous elements form an image that is visible in darkness, the semi-transparent layer is visible under normal lighting conditions and has a configuration that does not form an image, such that the hollows and said luminous elements are not visible under normal lighting conditions.

Claim 23. (New) The dial of claim 22 wherein said luminous elements are applied by serigraphy, tampography or manually onto said substrate plate and/or onto said semi-transparent layer.

Claim 24. (New) The dial of claim 22 wherein said semi-transparent layer is made of one of the following materials: mother-of-pearl; varnish; lacquer; glass; plastic.

Claim 25. (New) The dial of claim 22 wherein said colored layer is a coat of varnish.

Claim 26. (New) The dial of claim 22 wherein said blind hollows are made by machining or by selective chemical attack.

Authorization to Charge Deposit Account

5. Prior to this Examiner's Amendment, the application contained four (4) independent claims and thirteen (13) dependent claims for a total of seventeen (17) claims. This examiner's amendment changes the number of claims so that there are

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now five (5) independent claims and fifteen (15) dependent claims for a total of twenty (20) claims.

6. During a telephone conversation conducted on 17 October 2008, Joseph Weissman, no. 40,220, authorized the Director to charge Deposit Account No. 23-2185 (128118.00101) the required fee to pay \$220 for the additional independent claim, and to pay for any charges that may be associated with the additional dependent claims. A copy of this authorization is contained in the email communication received from the Applicant and included in this Examiner's Amendment as an attachment.

Allowable Subject Matter

7. The following is an examiner's statement of reasons for allowance:

8. Regarding claims 1, 10, 15, 21, and 22, the prior art of record does not teach or render obvious the process or apparatus having all of the required structure and functionality as claimed, including a semi-transparent layer visible under normal lighting conditions with a configuration that does not form an image, and having blind hollows containing luminous elements that are not visible under normal lighting conditions.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEO T. HINZE whose telephone number is (571)272-2864. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571.272.2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony H Nguyen/
Primary Examiner, Art Unit 2854

Leo T. Hinze
Patent Examiner
AU 2854
17 October 2008